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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/554,547 07/07/00 PAESEN

G 2488-1-001

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HM22/1003

EXAMINER

SORBELLO, E

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

15
10/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/554,547

Applicant(s)

PAESEN ET AL.

Examiner

Eleanor Sorbello

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by this Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claim

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Groups I-VII, claim(s) I-19, 24-28, 30, 31 each group drawn to a tissue cement protein comprising SEQ. ID. Nos: 1, 3, 6, 11, 14, 16 or 17 respectively and the first named method of use as vaccine.

Group VIII, claim(s) 20-23, 30 drawn to a pharmaceutical composition comprising a mixture of tissue cement proteins.

Groups IX-XV, claim 29 each group drawn to a method of bonding animal tissue, comprising administration of any one tissue cement protein comprising SEQ. ID. Nos: 1, 3, 6, 11, 14, 16 or 17 respectively.

Groups XVI-XXII, claims 32-38, each drawn to a nucleic acid encoding a tissue protein of SEQ. ID. Nos: 1, 3, 6, 11, 14, 16 or 17 respectively.

Groups XXIII-XXIX, claim 39, each group drawn to a transgenic animal containing nucleic acids encoding proteins comprising SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17 respectively.

2. **NOTE:** Claim 40 is objected to under PCT Rule 6.4(a), 35 U.S.C. 112, as being in improper form because a multiple dependent claim should refer to other claims in the alternative only and do not serve as a basis for any other multiple dependent claim.

Accordingly, the claim has not been considered.

3. The inventions listed as Groups I-XXIX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-VII, Groups IX-XV, Groups XVI-XXII, or Groups XXIII-XXIX do not share a common technical feature because they are directed to distinct cement proteins that do not share a common core structure.

Group VIII is directed to a pharmaceutical composition comprising any combination of a mixture of cement proteins which are selected from SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17.

Each combination does not necessarily show any common technical feature with any other combination or with any of the individual proteins selected from SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17.

Each of groups IX-XV is directed to a second method of using a mixture of tissue cement proteins comprising any combination which are selected from SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17, for bonding animal tissue. PCT Rules 13.1 and 13.2 do not provide for multiple products and methods within a general inventive concept. Note 37 CFR 1.475 and M.P.E.P 1895.01 (Section 4) and 1896. Therefore as discussed above, there is

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no common technical feature with any of the above mentioned groups due to different structures of the combinations.

Each of groups XVI-XXII is drawn to a nucleic acid encoding a cement tissue protein selected from SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17. There is no common technical feature between the nucleotide sequences encoding proteins of SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17 because each protein is distinct from each nucleotide in structure and function. Additionally, the nucleic acid can be used for hybridization studies and therefore has other functions other than encoding the proteins of the instant invention.

The Groups XXIII-XXIX each is drawn to a distinct transgenic animal transformed with a nucleic acid encoding a cement tissue protein comprising SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17. Therefore each transgenic animal does not share a common technical feature with any other transgenic animal comprising a different nucleic acid or with any other of the groups listed above.

4. Group VIII contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Any mixture comprising any of the following SEQ. ID. Nos. 1, 3, 6, 11, 14, 16 or 17.

Applicant is required, in reply to this action, to elect a single species ie. identify the SEQ. ID. Nos. that comprise the mixture, to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An

argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleanor Sorbello whose telephone number is 703-308-6043. The examiner can normally be reached on M-F: 6.30AM-3.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark can be reached on 703-305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3230 for regular communications and 703-305-3230 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

September 29, 2001

Scott D. Pribe

SCOTT D. PRIEBE, PH.D
PRIMARY EXAMINER